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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,988	02/12/2002	Chris E. Rowen	LEGAP002	3521

57255   7590   06/17/2008
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EXAMINER
CHANKONG, DOHM

ART UNIT	PAPER NUMBER
2152	

MAIL DATE	DELIVERY MODE
06/17/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/072,988	ROWEN, CHRIS E.
	Examiner	Art Unit
	DOHM CHANKONG	2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 February 2008*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,7,15,17-20 and 37-41* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-4, 7, 15, 17-20, and 37-41* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1>   This action is in response to Applicant's request for continued examination. Claims 5, 6, 8-14, 16, 21-36, and 42-44 are canceled. Claims 1, 15, and 37 are amended. So by way of Applicant's amendment, claims 1-4, 7, 15, 17-20, and 37-41 are presented for further examination.

2>   This is a non-final rejection.

Continued Examination Under 37 CFR 1.114

3>   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2.21.2008 has been entered.

Response to Arguments

4>   Applicant has amended the independent claims as follows: (1) incorporating limitations of dependent claims directed towards creating a message tag from the message sender and a message submission time. Applicant's arguments have been considered but are moot in view of the new ground of rejection set forth in this action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5>   Claims 1-4, 7, 15, 17-20, and 37-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the independent claims have been amended to now recite, *inter alia*, "wherein a copy of the message, if stored in the message archive, is retained for a prescribed period of time and is not subject to being deleted prior to the expiration of the retention period." This feature is not supported by Applicant's specification.

There is no discussion of a "retention period" or anything analogous to a period for archiving messages before they can be deleted. The only reference to this kind of feature is in relation to a possible use of Applicant's invention. Applicant's specification describes the need for a government agency to archive messages for at least 5 years [pg. 15, 0045]. The specification describes that the instant invention would be able to serve such a need because messages are archived externally rather than at the agency. However, beyond the use of an external archive and full-text searching, Applicant does not describe any features that are now part of the claims, in particular a message being stored for a prescribed period and that "is not subject to being deleted prior to expiration of the retention period." The specification

is silent as any feature that would allow a user to prescribe a period of time for retaining the

message nor is there any discussion of any features that would prevent attempted deletions

of the messages within that period of time.

What is described in the specification is merely an intended use for Applicant's

invention relying merely on the invention's use of an external archive to enable mass storage

of messages for an extended period of time. Therefore, this limitation lacks support from

Applicant's specification and the claim fails to meet the written description requirement. If

Applicant disagrees with this rejection, Applicant should cite sections in the specification

that clearly support the claimed features. The dependent claims are rejected based on their

dependency on their respective parent claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
> are such that the subject matter as a whole would have been obvious at the time the invention was made to a
> person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

6>   Claims 1 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hughes, U.S.

Patent No. 6.122.372, in view of Yeager, U.S. Patent No. 6.167.402.

7>   Hughes was cited in the PTO-892 filed on 10.17.2007. Yeager was cited in the PTO-892

filed on 12.22.2005.

8>   As to claim 1, Hughes discloses a method for identifying a unique electronic mail

message in a plurality of electronic mail messages extracted from an electronic mail

messaging system, the method comprising:

computing a message tag from a subset of the plurality of message properties,

including a message sender and a message submission time [column 10 «lines 30-35» | column

11 «lines 16-20» | Figure 2 where : Hughes hashes a "message set" where the message set

includes the "current time" and sender ID. Hughes describes the "current time" as "the time

that the message was sent by the sender];

reviewing a list of message tags stored in a single shared index file associated with

multiple electronic mail recipients wherein the message tags are stored in the single shared

index file are computed from respective messages [column 3 «lines 23-30» | column 19 «lines

17-27»: Hughes implies an index file through his teaching of searching for a match in the

database];

determining based upon whether the message tag is found in the single shared index

file whether the message is not a duplicate message already stored in a message archive

[column 19 «lines 17-27»];

storing the message tag in the single shared index file and storing the message in the

message archive if it is determined the message is not a duplicate message [column 19 «lines

37-47»]; and

wherein a copy of the message, if stored in the message archive, is retained for a

prescribed period of time and is not subject to being deleted prior to the expiration of the

retention period [column 10 «lines 30-33 and 47-52» : in one embodiment, Hughes "expiration

time" refers to "how long messages must be stored" | column 24 «lines 32-47» : "maximum

holding time"].

While Hughes does disclose that his invention is compatible with email messages

[column 8 «lines 43-45»] where the message includes a plurality of message properties

[Figure 2], Hughes does not expressly disclose (1) retrieving from a mailbox on the electronic

mail messaging system a copy of the message or (2) that the messages are retrieved from a

plurality of mailboxes associated with multiple electronic mail recipients. However, these

features of retrieving a copy of a message from a mailbox and retrieving messages from a

plurality of mailboxes associated with multiple electronic mail recipients was well known in

the art at the time of Applicant's invention.

For example, Yeager teaches these features in an invention directed towards a

message store that contains an index file [abstract]. Like Hughes, Yeager discloses hashing

email messages in order to prevent storing duplicate copies within a message store [column

10 «lines 5-7»]. As to the features not taught in Hughes, Yeager discloses (1) retrieving from a

mailbox on the electronic mail messaging system a copy of the message [column 2 «lines 49-

62» : teaching the well known feature of retrieving messages from a user's inbox] and (2) that

the messages are retrieved from a plurality of mailboxes associated with multiple electronic

mail recipients [column 2 «lines 49-62» | column 7 «lines 7-11»]. Despite not expressly

teaching a plurality of mailboxes, this feature is implied by the fact that there are multiple

mail recipients. It would have been obvious to one ordinary skill in the art to have reasonably

inferred the presence of multiple inboxes (and therefore retrieval from them) when there are

multiple recipients.

It would have been obvious to one of ordinary skill in the art to have modified

Hughes invention with Yeager's teachings retrieving and storing email messages. One would

have been motivated to adapt Hughes message store to be compatible with email systems to

increase the store's functionality and usefulness.

9>   As to claim 7, Hughes as modified by Yeager discloses the index file is stored in a

relationship database system [column 3 «lines 23-30» | column 19 «lines 17-27»].

10>   As to claims 15, 37, and 41, they are rejected for at least the same reasons set forth for

claim 1.

11>   As to claim 20, it is rejected for at least the same reasons set forth for claim 7.

12>   Claims 2, 3, 17, 18, 38, and 39 are rejected under 35 U.S.C. §103(a) as being unpatentable

over Hughes, in view of Yeager, in further view of Cloutier et al, U.S. Patent No. 6,535,586

["Cloutier"].

13>   Cloutier was cited in the PTO-892 filed on 8.17.2005.

14>   As to claim 2, while Hughes discloses computing a message tag by using a message's

properties, Hughes does not expressly disclose concatenating at least two properties selected

from the plurality of message properties. However, the concept of concatenating message

properties to calculate a message tag was well known in the art at the time of Applicant's invention.

For example, Cloutier teaches this feature in an invention directed towards generating unique codes for email messages [abstract]. Specifically, Cloutier discloses concatenating message properties to generate a message tag [column 6 «lines 5-35» : Cloutier discloses computing a checksum by appending the data from the Date and From header fields of the message]. It would have been obvious to one of ordinary skill in the art to have modified Hughes to include Cloutier's teachings of calculating a checksum from concatenating message properties. One would have been motivated to adapt Hughes in such a manner because Cloutier teaches that such a feature insures the generation of a unique code signature for each message thereby increasing the reliability of Hughes' invention.

15>   As to claim 3, Hughes as modified by Yeager and Cloutier discloses the message tag is further computed by applying a hash algorithm to the message tag to form a uniform string wherein the uniform string has a predetermined length [Hughes, column 10 «lines 30-35» | column 11 «lines 16-20» | Figure 2 & Cloutier, column 6 «lines 5-35»].

16>   As to claims 17 and 38, they are rejected for at least the same reasons set forth for claim 2.

17>   As to claims 18 and 39, they are rejected for at least the same reasons set forth for claim 3.

18>   Claims 4, 19, and 40 are rejected under 35 U.S.C. §103(a) as being unpatentable over

Hughes, in view of Yeager and Cloutier, in further view of Mattis et al, U.S. Patent No.

6.292.880 ["Mattis"].

19>   Mattis was cited in the PTO-892 filed on 6.19.2006.

20>   As to claim 4, while Hughes as modified by Yeager and Cloutier teaches hashing

message properties, Hughes does not expressly disclose utilizing MD5 as the hash algorithm.

However, implementing MD5 as a hash algorithm with respect to messages was well known

in the art at the time of Applicant's invention.

Mattis expressly discloses hashing message tags using the MD5 algorithm to form a

uniform string [column 9 «lines 48-63»]. It would have been obvious to one of ordinary skill

in the art to have implemented Hughes hashing algorithm as an MD5 algorithm. The MD5

hashing algorithm was well known in the art at the time of Hughes invention.

21>   As to claims 19 and 40, they are rejected for at least the same reasons set forth for

claim 4.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dohm Chankong/
Examiner, Art Unit 2152